

REMARKS

Claim 10 is currently pending in this application. Reexamination and reconsideration of the application are respectively requested.

Applicant would like to thank Examiner's supervisor, Brian Casler, for the phone interview on May 27, 2003. The finality of the current Office action was discussed, and Mr. Casler stated that the current Office action will be treated as a non-final Office action.

Claim Rejections Under 35 U.S.C. §103

Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Jang (U.S. Patent No. 5,462,530) in view of Hughes (U.S. Patent No. 268,407). The rejection is respectfully traversed.

First, M.P.E.P. § 2141.01(a) states that a reference relied on under 35 U.S.C. §103(a) must be analogous prior art. In this rejection, the Examiner relies on Hughes which discloses a surgical tourniquet. A surgical tourniquet is not analogous to a method for positioning a catheter assembly, because it is not in the same field of endeavor and it is not reasonably pertinent to the particular problem with which the current application is concerned.

isn't analogous

Second, as stated in M.P.E.P. § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

M.P.E.P. § 2143.01 also states that a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

I do have motivation

Applicant respectfully submits that the Examiner has failed to show the motivation or suggestion found in the references themselves or in the knowledge available to one of ordinary skill in the art. There is no motivation or suggestion found in either reference to combine the intravascular catheter of Jang with the surgical tourniquet of Hughes. A person of ordinary skill in the art would not look to a patent for a surgical tourniquet if he is trying to modify a catheter assembly. Further, the present application solves the problem of guide wires crossing and wrapping outside of the body, and neither reference mentions or recognizes the existence of this problem precluding a finding of obviousness with regard to the claimed solution thereto.

Combining the retaining member

Third, there is no reasonable expectation of success of combining a surgical tourniquet with a catheter.

yes, —

Finally, not all elements of claim 10 are taught or suggested by Jang and Hughes because neither discloses a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter. Hughes discloses a surgical tourniquet that includes a block A that holds rubber tubing, not a retaining element for retaining guide wires. For all of these reasons, claim 10 is patentable over Jang in view of Hughes.

Examiner also rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over Jang (U.S. Patent No. 5,462,530) in view of Martin (U.S. Patent No. 5,366,444). This rejection is respectfully traversed.

Applicant respectfully submits that the Examiner has failed to show the motivation or suggestion found in the references themselves or in the knowledge available to one of ordinary skill in the art, which is needed to establish a *prima facie* case of obviousness. Applicant respectfully submits that there is no motivation or suggestion found in either reference to combine the intravascular catheter of Jang with the hand operated guide wire advancement device. Further, Jang and Martin do not mention or recognize the existence of the problem that is solved by the present invention which precludes a finding of obviousness with regard to the claimed solution thereto.

- yes, no, just need

Also, Applicant respectfully submits that not all elements of claim 10 are taught or suggested by Jang and Martin because neither discloses a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter. Martin discloses a guide wire advancement device that includes a coiled tube 24 which houses a single guide wire, and clips 26 and 28 that hold the coiled tube in place. Martin does not disclose a retaining element for retaining two guide wires in a spaced apart relationship. For these reasons claim 10 is patentable over Jang in view of Martin.

Examiner further rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over Jang (U.S. Patent No. 5,462,530) in view of Lahay (U.S. Patent No. 6,696,920). This rejection is also respectfully traversed.

Applicant respectfully submits that the Examiner has failed to show the motivation or suggestion found in the references themselves or in the knowledge available to one of ordinary skill in the art, which is needed to establish a *prima facie* case of obviousness. Applicant respectfully submits that there is no motivation or suggestion found in either reference to combine the intravascular catheter of Jang with the organizing device disclosed in Lahay. Jang does not provide any suggestion that an organizing device is needed to separate guide wires proximal to the catheter, and Lahay does not mention the ability to retain two separate guide wires proximal to a catheter. Neither Jang nor Lahay mention or recognize the existence of the problem that is solved by the present invention precluding a finding of obviousness with regard to the claimed solution thereto.

Further, Applicant respectfully submits that not all elements of claim 10 are taught or suggested by Jang and Lahay because neither discloses a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter. Lahay only discloses an organizing device including a block of semi-rigid foam, and not a retaining element for retaining guide wires. For all of these reasons, claim 10 is also patentable over Jang in view of Lahay.

Examiner has also rejection claim 10 under 35 U.S.C. §103(a) as being unpatentable over Jang (U.S. Patent No. 5,462,530) in view of Byrnes et al. (U.S. Patent No. 6,405,530). This rejection is respectfully traversed.

Applicant respectfully submits that the Examiner has failed to show the motivation or suggestion found in the references themselves or in the knowledge available to one of

ordinary skill in the art, which is needed to establish a *prima facie* case of obviousness. Applicant respectfully submits that there is no motivation or suggestion found in either reference to combine the intravascular catheter of Jang with the coiled clip and spiral dispenser of Byrnes et al. Further, neither reference mentions or recognizes the existence of the problem that is solved by the present invention precluding a finding of obviousness with regard to the claimed solution thereto.

Also, not all elements of claim 10 are taught or suggested by Jang and Byrnes et al. because neither discloses a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter. Byrnes et al. discloses a coiling clip for holding a protective tube, and not a retaining member for holding guide wires in a spaced apart relationship. For all of these reasons, claim 10 is patentable over Jang in view of Byrnes et al.

Claim 10 is also rejected under 35 U.S.C. §103(a) as being unpatentable over Jang (U.S. Patent No. 5,462,530) in view of EP 0 587 984 A1 ("the European reference"). This rejection is respectfully traversed.

Applicant respectfully submits that the Examiner has failed to show the motivation or suggestion found in the references themselves or in the knowledge available to one of ordinary skill in the art, which is needed to establish a *prima facie* case of obviousness. There is no motivation or suggestion found in either reference to combine the intravascular catheter of Jang with the guide wire advancement device shown in the European reference. A person of ordinary skill in the art would not combine the intravascular catheter of Jang with the clips for holding a tube in a coiled position found

in the guide wire advancement device of the European reference to retain guide wires. Further, Jang and the European reference do not mention or recognize the existence of the problem that is solved by the present invention which precludes a finding of obviousness with regard to the claimed solution thereto.

Also, Applicant respectfully submits that not all elements of claim 10 are taught or suggested by Jang and the European reference because neither discloses a retaining element for retaining the tracking guide wire and the integrated guide wire in a spaced apart relationship proximal to the elongated catheter. The European reference discloses a guide wire advancement device that includes a coiled tube 11 which houses a single guide wire 13, and a clip 60 that holds the coiled tube in place. The European reference does not disclose a retaining element for retaining two guide wires in a spaced apart relationship. For these reasons claim 10 is patentable of Jang in view of the European reference.

CONCLUSION

In view of the foregoing, applicant respectfully submits that claim 10 is in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited.

Respectfully submitted,

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